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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,568	03/11/2004	Perry A. Cohagan	03292.101800.2	2567
66569	7590	09/09/2008	EXAMINER	
FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				ALVAREZ, RAQUEL
ART UNIT		PAPER NUMBER		
3688				
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			09/09/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/708,568	COHAGAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Raquel Alvarez	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 March 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-21 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/15/04, 2/2/06, 4/2/07</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

1. This office action is in response to communication filed on 3/11/2004.
2. Claims 1-21 are presented for examination.

### **Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Based on Supreme Court precedent <sup>1</sup> and recent Federal Circuit decisions, a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. <sup>2</sup> If either of these requirements is met by the claim, the method is non a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter.

**Claim 1** is rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. The applicant is reciting only method steps such as “maintaining... receiving....determining”, the applicant has not recited an apparatus or device to perform these limitations and without apparatus or device these limitations are just mental steps. Mentioning computer in the preamble is not enough, if the body of the claims each of the steps can be performed manually.

In claims 1 the steps are related to a mental process, which is not patentable. Indeed, it is not tied to another statutory class or does not change or switch statutory

class (such as a particular apparatus or physical module or device) or does not transform the underlying subject matter (such as an article or materials) to a different state or thing. See MPEP §2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category.*

Examiner suggests applicant inserts a device in one or more steps of the body of the claims in order to overcome this rejection.

<sup>1</sup> Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> The supreme court recognized that this test is not necessary fixed or permanent and may evolve with technological advances. Gottschalk v. Benson, 409 U.S. 63,71 (1972)

### **Double Patenting**

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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6. Claims 1-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/708,570. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites transferring points between accounts, one of the accounts being a charity. Official Notice is taken that it is old and well known to transfer accounts between accounts including one of the accounts belonging to a charity in order to allow participants to give back to the charity of their choice by allowing them the convenience of transferring earned points or discounts to a second party. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transferring points between accounts, one of the accounts being a charity in order to obtain the above mentioned advantage.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Brizendine et al. (6,484,147 hereinafter Brizendine) in view of Scroggie et al. (5,970,469 hereinafter Scroggie).

With respect to claims 1-3, 11, 14 -15, 17, 19 Brizendine teaches a method for facilitating a transfer points between at least two loyalty accounts (Abstract). Maintaining a database for storing at least one loyalty points in at least one loyalty account corresponding to at least one consumer (Figure 3, 300); receiving a transfer request to transfer a number of loyalty points from a first loyalty account to at least a second loyalty account as a gift (i.e. member 130 request to load points to member 120)(event 902); determining loyalty points requested for transfer and acquiring data related to loyalty point balance of a first loyalty account (event 910); deducting a portion of loyalty point balance of said first loyalty account and crediting the loyalty point balance of said second loyalty account (see Figure 9).

Brizendine doesn't specifically teach that the loyalty account is associated with a geographic area. On the other hand, Scroggie teaches the user required to enter his or her **zip code** in order to receive location-dependent offers (see Figure 3). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Scroggie of geographic area points/offers/incentives in the loyalty account of Brizendine because such a motivation would allow to better target the offers of Brizendine based on the market area that the customer resides in.

Claim 4 further recites determining if there are any restrictions or limitations on said transfer (i.e. determining if the account is that of a minor in order to notify the parent/guardian of the points withdrawn)(See Figure 14).

With respect to claim 5, Brizendine further teaches a certain time period (i.e. expiration date) where the loyalty account becomes invalid)(col. 6, lines 59-64).

With respect to claim 6, Brizendine further teaches converting a portion of said loyalty points to a monetary value (step 908).

Claim 7 further recites calculating an exchange rate between geographic areas. Official Notice is taken that it is old and well known to have exchange rates and conversion rates between geographic areas. For example, when traveling overseas and the like, the customer is presented with a list of currency and their corresponding conversion rate in order to provide and aid the customer with the calculation of how much money they will receive for exchanging to the area/geographic currency rate. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included calculating an exchange rate between geographic areas in order to achieve the above mentioned advantage.

With respect to claim 8, Brizendine further teaches crediting a third loyalty account (i.e. crediting an educational institution)(see Figure 14).

With respect to claim 9, Brizendine further teaches notifying at least one club member of second loyalty point account transfer (see Figure 14 of notification of amount withdrawn).

Claims 10 and 16 further recite the second loyalty account being associated with a government approved charity. Official Notice is taken that it is old and well known to have a list of government approved charities that the members can transfer money to. For example, Combined Federal Campaign (CFC) it is an authorized fundraiser of local and national charities that have met CFC guidelines and an easy way for federal employees to transfer certain payroll amount to the charities of their choice. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the second loyalty account being associated with a government approved charity in order to obtain the above mentioned advantages.

Claim 12 further recites determining if said loyalty points of said first member is below a threshold amount. Official Notice is taken that it is old and well known to determine if a member amount is below a threshold amount in order to approve or disapprove a withdrawal. For example, banks and the like will not allow an account holder to have a balance below a threshold amount in order to maintain a free checking account. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included determining if said loyalty points of said first

member is below a threshold amount in order to determine if the member qualifies for certain services.

Claim 13 further recites determining if said loyalty points of said first member has been inactive for a certain time period. Official Notice is taken that it is old and well known to determine if a member amount has been inactive for a certain period of time. For example, loyalty programs and the like will track if a user is not redeeming points or the like in order to determine if the user should receive additional points/incentives/coupons. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included determining if said loyalty points of said first member has been inactive for a certain time period in order to determine if the member's account should be closed.

With respect to claim 18, Scroggie further teaches redeeming loyalty points in a predetermined geographic area (col. 11, lines 57-65). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included redeeming the points/incentives in a particular geographic location in order to promote purchase at a particular retailer. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included teaches redeeming loyalty points in a predetermined geographic area in order to obtain the above mentioned advantage.

With respect to claim 21, Brizendine further teaches informing a consumer of said transfer of loyalty points in real-time at a point of sale (Figure 10).

**Point of contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on (571)272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner, Art Unit 3688

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9/5/2008

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